

# **In the United States Patent and Trademark Office**

In re the Application of:

Carl Phillip Gusler	)	
Serial Number: 09/864,113	)	Before the Board of Patent Appeals
Docket Number: AUS920010251US1	)	Administrative Patent Judges:
	)	Hubert C. Lorin
Filed on: 5/24/2001	)	Stuart S. Levy
	)	and, Anton W. Fetting
For: "Online Shopping Mall Virtual	)	
Association"	)	

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## **REQUEST FOR REHEARING UNDER 37 CFR §1.197(b)**

### **Adverse Decision in the Appeal 2007-1867**

Appellant respectfully requests a rehearing of the Appeal from the final rejections of the claims of U.S. patent application serial number 09/864,113, attorney docket number AUS920010251US1.

### **Points Believed Misapprehended in Rendering the Adverse Decision**

In the Decision, a pivotal point in the reasoning was the definition afforded to the claim term "disassociated". Appellant argued for a definition which would define members of a common organization, such as Odigo.com group, as being "associated" by virtue of common membership only, without requiring an previous social contact between them. Thus, "disassociated" would be online two or more users who did not belong to a common group or organization, according to Appellant's argument.

The Board applied a definition of "disassociated" as including only members of Odigo.com who had also struck up a social relationship. Odigo.com members who had not socially interacted with each other would fall into the definition of "disassociated", and thus the claim term "disassociated" read upon and was anticipated by Odigo.com, according to the definition applied in the Decision.

Appellant respectfully disagrees, and requests rehearing and reconsideration for the following reasons:

- (a) the definition applied by the Board was not commensurate with the disclosure, and thus does not follow case law related to interpreting claims in the context of the disclosure; and
- (b) the definition applied by the Board was overly narrow, whereas Case law requires use of the broadest definition of the term which is reasonable and commensurate with the Appellants disclosure.

### **Definitions of Disassociated and Associated**

The claims employed the term "disassociated". In the Decision (page 2, line 1), it was reasoned that:

02. Disassociate means to remove from association<sup>2</sup>.

citing the American Heritage Dictionary of the English Language, Fourth Edition, 2000.

Appellant agrees, whereas "disassociate" is the antonym of "associate". Also, in the Decision, it was reasoned that:

03. To associate, in the context of shoppers, means to spend time socially; keep company<sup>2,3</sup>.

citing American Heritage Dictionary, as well as Appellant's Brief on page 7, second definition, taken from Merriam-Webster's Dictionary, 1996, which was:

#### **Appellant's Brief, Page 7:**

association (noun)

1 : a group of persons who share common interests or a common purpose and who are organized with varying degrees of formality  
—compare CORPORATION

2 : the act of having contact or communication with or keeping company with another <freedom of association>

3 : the sharing (as by an aider and abettor) in the criminal intent of a

person who commits a crime

Appellant agrees that the definition applied by the Board in the decision (e.g. "spending time together socially" and "keeping company") corresponds to the second definition from Merriam-Webster, but respectfully points out that Appellant's argument was supported by Merriam-Websters first definition (Appellant's Brief, pg. 7, lines 17 - 19):

1 : a group of persons who share common interests or a common purpose and who are organized (Merriam-Webster)

This definition requires only two conditions (1) the persons in the group must share a common purpose or interest, and (2) they are "organized". This definition also allows for "varying degrees of formality" of organization.

Appellant respectfully submits that selection of the degree for formality of organization and whether or not persons have common membership but not previous social relationship is pivotal in determining patentability of Appellant's claims.

Appellant respectfully submits that the definition and scope of the term "disassociate" and "associate" were misapprehended in the rendering of the Decision.

#### Looking to the Specification for the Claim Term Definitions

While case law indicates that the specification is not to be read into the claims per case citations provided in the Decision, the Court has also stipulated that the claim terms must be construed in the context of the disclosure because the claims are part of the disclosure (35 U.S.C. §112), and because one of ordinary skill in the art would read the claims in the context of the disclosure (Phillips v. AWH Corp., 2005):

#### 35 U.S.C. 112:

...

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant

regards as his invention.

...

*Federal Circuit regarding Interpretation of Claim Terms in view of Inventor's Disclosure:*

"Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification."

...

"For that reason, claims must be read in view of the specification, of which they are part . . . [T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term . . . "

"Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. . . . In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as express in the specification, is regarded as dispositive." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc).

Appellant respectfully submits that Appellant's disclosure provides examples of "associated" web surfers as persons who have previously joined a common group, such as American Online's Instant Messenger community. Appellant respectfully submits that joining AOL-IM is similar to joining Odigo.com - one may join or sign up but does not necessarily have to meet or communicate with anyone to be "associated". Many members of many groups or organizations can be described as "observers" or "inactive" due to their use of group services and benefits without forming social relationships with other members, for example.

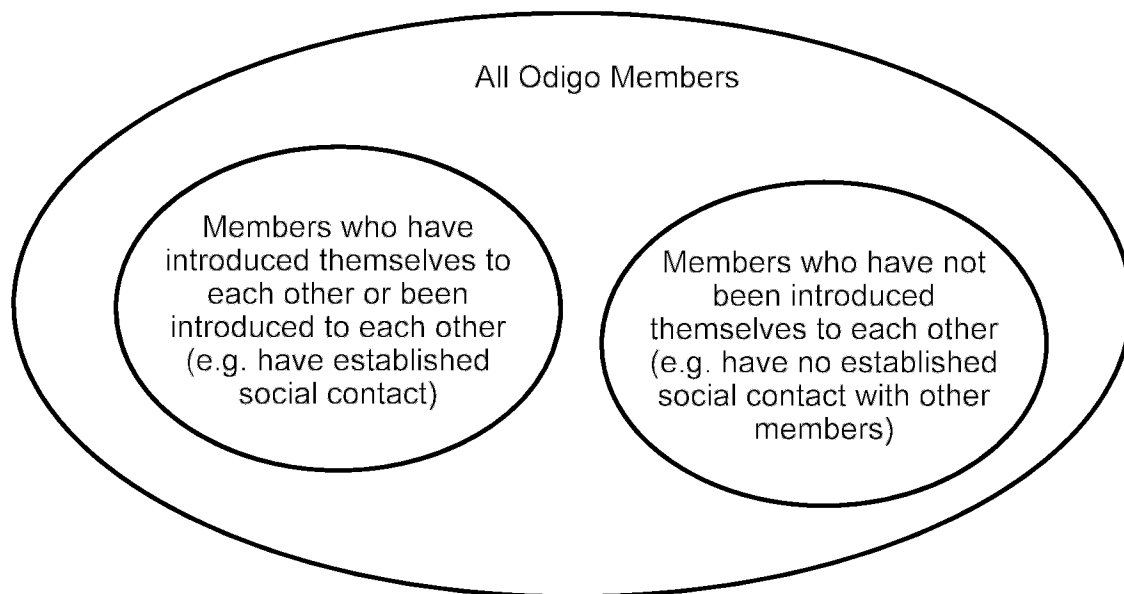
For this reason, Appellant respectfully requests the Board to reconsider its applied definition of "associate" and "disassociate" to be commensurate with the disclosure and with Merriam-Webster's first definition:

"a group of persons who share common interests or a common purpose and who are organized with varying degrees of formality"

without requiring an additional condition of having previous social contact with other members of the same organization.

Using the Broadest Definition of Terms Reasonably Commensurate with the Specification

Case law, and Patent Office practice, agree that the broadest definition of a claim term should be used in construing a claim, but within the scope set forth in the disclosure, such as *In re Prater* (cited in the Decision at page 6, lines 10 - 14). Appellant respectfully submits that in rendering its decision, the Board has selected and applied not the broader, but the narrower definition of the term "disassociate". Comparison of the different definitions of "associate" lends itself well to a Venn Diagram in which Odigo members can be separated into two groups:

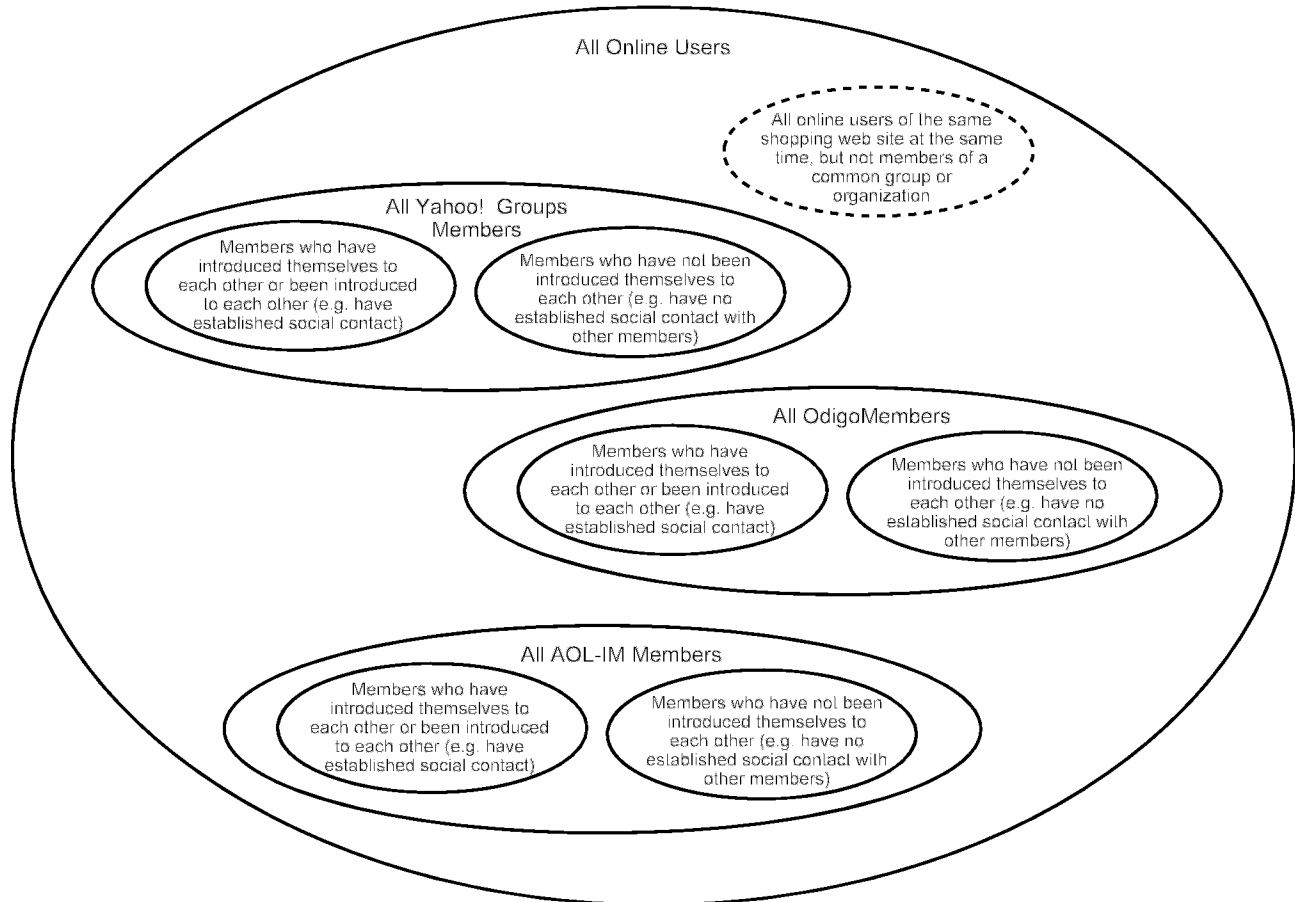


The Board has applied the definition which would only encompass the leftmost sub-group of Odigo members, whereas Appellant is arguing to apply the *broadest* definition of all Odigo members which encompasses *both* sub-groups.

As such, Appellant respectfully submits that it is not only consistent with Appellant's disclosure to apply the definition of "a group of persons who share common interests or a common purpose and who are organized with varying degrees of formality" without requiring actual social interaction, but it is also indicated as correct by the Court to apply the broadest

reasonable definition. The Board's decision relies upon the narrower interpretation of "association", which Appellant respectfully submits is inconsistent with Appellant's disclosure, and inconsistent with case law.

Appellant's claims are appropriately shown in Venn form as follows:



In this diagram, the group of users shown with the dotted line represents the limits of Appellant's claim, which is distinct and non-overlapping with any users who share common membership through an online social group or service. Thus, Appellant's claims, when interpreted with the broadest reasonable scope commensurate with the disclosure are not anticipated by the cited reference which requires Odigo membership in order to introduce shoppers.

"Association" By Virtue of Being Common Species of Creatures

In the Decision (page 12), it was proposed that under an extremely broad definition of "association" all humans are "associated" by virtue of being the same species. Appellant respectfully submits that this definition would be inappropriate for the following reasons:

- (a) Appellant's invention relates to the arts of online commerce, not the biological arts, so a reasonable reader would interpret the term not in the context of organization of species, but in the context of organization of online web site users;
- (b) not all humans "share common interests" or "common purpose", and thus not all humans are "associated" per the first Merriam-Webster definition; and
- (c) all humans are born human, and thus do not "join" the human race but are by default humans, nor can they "disassociate" by leaving the species.

Further, if such a broad definition were appropriate, the cited art would have to show technology that finds all humans, online or not. Certainly, Odigo does not propose or enable to do that.

Inherency of Social Nature of Online Shopping

In the Decision (pg. 11), it was reasoned:

*Board's Decision:*

. . . Clearly, the environment of the invention is a shopping environment, an inherently social environment. . . .

Applicant respectfully submits that this is untrue. While a real shopping environment, such as a real mall or real retail store, may be inherently social in nature, *online* shopping is not. Online shopping is usually done alone, using a computer and a web browser, and thus is inherently a lonely environment, which is the object of the present invention (e.g. providing a more social aspect to online shopping). Applicant's claims are limited to online shopping (e.g. users of a "virtual shopping resource"), and thus there is no inherent social aspect present in the scope of Applicant's claims.

Summary

Appellant respectfully asks for the broader definition of "associate" to be used in accordance with relevant case law and commensurate with Appellant's disclosure in the reconsideration of the Board's decision. Appellant requests this reconsideration because Appellant believes that the Board's decision pivots on this point in favor of patentability.

By requesting rehearing on these points, Appellant does not stipulate to any other ground or argument presented in the Decision, maintains all other arguments, and reserves all rights to further review under 35 U.S.C. §141 and §145.

Respectfully,

*/ Robert Frantz /*

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